

REMARKS

In response to the October 14, 2005 Office Action, Applicants hereby elect, with traverse, Group I (including claims 1-18) and gene TLR2 for prosecution on the merits. If the Examiner insists on an election of a single SEQ ID NO, Applicants hereby elect, with traverse, SEQ ID NO:1 for prosecution on the merits. SEQ ID NO:1 represents a nucleic acid sequence encoded by gene TLR2. Gene TLR2 is also represented by CPS No. 1 (consisting of nucleotides 2325-2635 of SEQ ID NO:1), SEQ ID NO:240, qualifier 40310_at, and accession number AF051152. Gene TLR2 encodes toll-like receptor 2. *See* Tables 2-4 and paragraph 77 of the specification.

Claims 1-20 are pending. By this amendment, Applicants have withdrawn, with traverse, claims 19-20. Applicants reserve the right to pursue the withdrawn claims in a divisional or continuation application(s).

The Office Action requires Applicants to elect one of the following groups for prosecution on the merits:

Group I, including claims 1-18, allegedly drawn to methods of comparing expression profiles of a sample and a reference;

Group II, including claim 19, allegedly drawn to a kit comprising a polynucleotide or an antibody; or

Group III, including claim 20, allegedly drawn to a computer system.

The Office Action also requires Applicants to elect a single SEQ ID NO for prosecution on the merits. For the reasons set forth below, Applicants respectfully traverse the restriction requirement.

Applicants respectfully submit that the restriction requirement mischaracterizes Applicants' invention. Claim 1 relates to the comparison of expression profiles of genes that are differentially expressed in peripheral blood mononuclear cells (PBMCs) of solid tumor patients as compared to disease-free humans. Claim 1 does not recite any specific sequences. By requiring an election of a specific SEQ ID NO, the Office Action effectively removes the term "gene" from claim 1 and thereby changes the subject matter of the claim. This is because a sequence (e.g., an enhancer) may represent a gene but is not expressible. Based on the above reasons, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement for a single SEQ ID NO.

Applicants also respectfully direct the Examiner's attention to MPEP §803.04, which states that "to further aid the biotechnology industry in protecting its intellectual property

without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application.” MPEP §803.04 further states that “[i]t has been determined that normally ten sequences constitute a reasonable number for examination purposes.” (Emphasis added). Accordingly, Applicants respectfully request the Examiner to withdraw the restriction requirement for a single SEQ ID NO and allow Applicants to elect ten genes for prosecution on the merits.

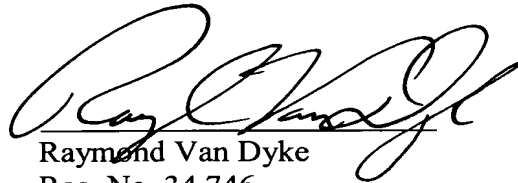
In addition, Applicants respectfully submit that the Examiner’s restriction to one of Groups I, II and III is improper. MPEP § 803 states “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Without agreeing or disagreeing with the contention that Groups I-III are distinct or independent inventions, Applicants respectfully submit that the search and examination of Groups I-III do not impose a serious burden upon the Examiner. For instance, all of the claims in Groups I-III are based on genes that are differentially expressed in PBMCs of non-blood disease patients as compared to disease-free humans. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement with respect to Groups I-III.

CONCLUSION

Although Applicants believe that no fee is due for the instant response, the Commissioner is hereby authorized to charge any payment deficiency to deposit account number 19-2380 (31896-12000).

Should the Examiner have any questions that would facilitate further prosecution or allowance of this case, the Examiner is invited to contact Applicants' representative designated below.

Respectfully submitted,



Raymond Van Dyke
Reg. No. 34,746

Date: November 7, 2005

Nixon Peabody LLP
Suite 900
401 9th Street, N.W.
Washington, D.C. 20004-2128
Tel: (202) 585-8250